

**Remarks**

The Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks.

Claims 1-3<sup>1</sup> are pending in the Application. The Applicants have amended claims 1-2, 4, and 6-13 and have added new claims 16-30.<sup>1</sup> α

**Claim Objections**

In the Office action dated February 23, 2004 (the "Office Action"), the Examiner objected to claims 7, 12, and 13 as including informalities in the dependency information. Applicants have amended claim 7 to depend on claim 6, and have amended claims 12 and 13 to depend on claim 11, as was assumed by the Examiner for consideration on the merits.

**Claim Rejections – 35 U.S.C. § 112**

The Examiner rejected claims 2 and 4 under 35 U.S.C. § 112, second paragraph as being indefinite.

Specifically, with respect to claim 2 the Examiner stated, "it is not clear what a contact sheet is and whether or not it contains album tiles prior to making it." [Office Action at 3.] The Applicants respectfully disagree that the term "contact sheet" is indefinite in claim 2, but have amended claim 2 to expedite prosecution. Claim 2 now recites a "contact sheet image." [See Application, ¶ [0008].] The "contact sheet image" of claim 2 includes "representations of the images contained in the album."

Accordingly, the Applicants respectfully submit that claim 2 meets the requirements of Section 112.

With respect to claim 4, the Examiner stated that it is not clear if the user "makes" one or more modifications, as recited in the claim, or whether the claim should recite that the user "made" one or more modifications, because "prompting" occurs prior to "adjusting the image". [Office Action at 3.] The Applicants respectfully disagree, but have amended claim 4 to expedite prosecution by removing the language the Examiner objects to in claim 4.

The Examiner also stated that it is not clear whether the "ensuring" in claim 4 is done manually or automatically. In claim 4, the ensuring may be done manually, automatically, or even

by some combination of manual and automatic operations. A claim term may be broad, but that does not make it indefinite. [M.P.E.P. 2173.04, BREADTH IS NOT INDEFINITENESS.]

Accordingly, the Applicants respectfully submit that claim 4 meets the requirements of Section 112, paragraph 2.

### **Claim Rejections – 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-15 as being unpatentable over U.S. Publication No. 2002/0122067 A1 to Geigel et al. [“Geigel”] in view of U.S. Publication No. 2002/0126141 A1 to Mastronardi [“Mastronardi”].

#### **I. Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest several limitations in each of claims 1-15**

Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest at least several limitations of each of claims 1-15. First, Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest the following language of claims 1, 6, and 11, respectively.

Claim 1 recites:

- a) displaying, to a user, a group of images for which corresponding image files are available;
- b) prompting the user to select a plurality of images from the group;
- c) prompting the user to save selected images as an album of images;

Claim 6 recites:

- a) display, to a user, a group of images for which corresponding image files are available;
- b) prompt the user to select a plurality of images from the group;
- c) prompt the user to save one or more selected images as an album of images;

Claim 11 recites:

- a) means for displaying, to a user, a group of images for which corresponding image files are available;
- b) means for prompting the user to select a plurality of images from the group;
- c) means for prompting the user to save selected images as an album of images;

Geigel does not teach or suggest, and in fact leads away from, the above-cited language of claims 1, 6, and 11, respectively. [M.P.E.P 2141.02, PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.]

Geigel describes a system and method for automatic layout of images in digital albums. [Geigel, Abstract.] The user inputs into the Geigel system an entire collection of images, such as from a digital camera. [See Geigel, ¶ [0055], [0056].] The Geigel system does not display images and prompt the user to select images to be included in an album from the collection of images that were input. In contrast, in several respects, Geigel teaches directly away from prompting for such input from the user:

[0055] A complete *albuming automation* system utilizes various image science algorithms and techniques including advanced event clustering, dud detection, image appeal and automatic page layout. In an illustrative embodiment, the emphasis of such a system is for a "DAFY" (Do-it-All-For-You) like product, where the user inputs a collection of images and the system produces an album (a collection of images) *with minimal input from the user.*

[emphasis added; see also paragraph [0009].]

Automating album creation with minimal input from the user (as in Geigel) leads directly away from the above-cited language of claims 1, 6, and 11, respectively. Further, Geigel describes the automated system as including "Dud/Duplicate Detection" in paragraph [0061]. Automated processing to detect "dud" or "duplicate" pictures also leads away from the above-cited language of claims 1, 6, and 11, respectively.

The Examiner states that Geigel teaches "prompting the user to select a plurality of selected images from the group" at paragraph [0010]. [Office Action at 3.] The Applicants respectfully disagree. Paragraph [0010] of Geigel describes an "automated album layout method" that takes a set of image objects and assigns "*each* image object to a page." [Emphasis added.] After the automatic method has created a page of the album, the page may then be displayed for "distribution refining" based on user input. [Geigel at ¶ [0010].] The "distribution refining" involves refinement of user-specified graphic design parameter preferences. [See Geigel at ¶ [0056], [0085].] Specifying or refining graphic design parameter preferences leads away from the above-cited language of claims 1, 6, and 11, respectively.

Mastronardi describes a process for selecting a recording on a digital audiovisual reproduction system, or in other words a digital jukebox. [Mastronardi at ¶ [0002].] Using user-friendly windows, a user can select a visual or sound recording that is stored in compressed digital form in bulk storage. [Mastronardi at ¶¶ [0008], [0014].] Selecting recordings to be recorded by a *digital jukebox* (as in Mastronardi) does not involve selecting images *for an album of images*, and Mastronardi does not teach or suggest the above-cited language from claims 1, 6, and 11,

respectively. Accordingly, Mastronardi does not make up for the deficiencies of Geigel with respect to claims 1, 6, and 11, respectively.

Second, Geigel and Mastronardi, taken separately or in combination, fail to teach or suggest the following language of claims 1, 6, and 11, respectively.

Claim 1 recites:

- e) making a copy of each image file that corresponds to one of the selected images to result in image file copies;
- f) compressing the image file copies.

Claim 6 recites:

- e) make a copy of each image file that corresponds to one of the one or more selected images to result in one or more image file copies;
- f) compress the one or more image file copies.

Claim 11 recites:

- e) means for making a copy of each image file that corresponds to one of the selected images to result in image file copies.;
- f) means for compressing the image file copies.

Geigel fails to teach or suggest the above-cited language of claims 1, 6, and 11, respectively. Indeed, once again Geigel teaches away from the claim language. [M.P.E.P 2141.02, PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS.] Geigel describes processing the input images and then producing an output, but does not describe making and compressing copies of the underlying image files. [See e.g., Geigel Fig. 1.]

In the Office Action, the Examiner cited paragraph [0061] of Geigel. Paragraph [0061] describes a “Dud/Duplicate Detection” method. This paragraph does not teach or suggest making duplicate copies of image files, it teaches detecting duplicates. [Geigel at ¶ [0061].] In fact, Geigel teaches away from making and compressing duplicates: “duplicates and duds [are] **removed** from the system.” [Geigel at ¶ [0077].]

As noted above, Mastronardi describes a process for selecting a recording on a digital audiovisual reproduction system, or in other words a digital jukebox. [Mastronardi at ¶ [0002].] Using user-friendly windows, a user can select a visual or sound recording that is stored in compressed digital form in bulk storage. [Mastronardi at ¶¶ [0008], [0014].] Mastronardi does not involve images *for an album of images*, and Mastronardi does not teach or suggest the above-cited

language from claims 1, 6, and 11, respectively. Accordingly, Mastronardi does not make up for the deficiencies of Geigel with respect to claims 1, 6, and 11, respectively.

For each of claims 1, 6, and 11, neither Geigel nor Mastronardi individually teaches or suggests the above-cited language. Accordingly, the combination of these references also fails to teach or suggest the above-cited language, and claims 1, 6, and 11 should be allowable.


In view of the foregoing remarks, the Applicants will not belabor the merits of the separate patentability of dependent claims 2-5, 7-10, and 12-15 at this point.

**Conclusion**

The claims in their present form should now be allowed. Such action is respectfully requested.

Respectfully submitted,

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